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EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
2686	12

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,290

Applicant(s)

KOSKELAINEN, PETRI

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-30 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10-13, 15-21, 23-25, 27-30, 32, 33 and 35-39 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 22, 26 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 11-13, filed December 8, 2003, with respect to the rejection(s) of claim(s) 1-7, 32-35 and 37-40 under Sasuta and claims 1, 8, 9, 18, 19, 21, 23-26, 37 and 38 under Rosenberg have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Mukherjee et al. (U.S. Patent Application Publication No. 2003/0073440).

The examiner notes the applicant's argument that presence data does not anticipate the "service information" recited in the claims. The applicant argues that "service is information is that information which is utilized to allow the user to continue their communication services at a new or recovered terminal." See page 13 of the arguments. However, this argument is unpersuasive because although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. Applicant's arguments with respect to claims 10-13, 15-17 and 27-30 have been fully considered but they are not persuasive.

The applicant argues that the Holmes-Kinsella reference teaches away from the claimed invention "because it operates on the premise of identifying terminals rather than having service information be provided upon identification of a user using the device." See page 14 of the arguments. However, the examiner disagrees with this

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characterization of the reference. Holmes-Kinsella discloses that a user accesses a service provider with a new device, and if the service provider does not recognize the new device, the user is provided with the opportunity to add the new device to his existing account. See paragraphs 22 and 23. The new device may be added to the account, and service information may be provided to the user, but only after the user provides account identification to the service provider. The account identification may be "an account number, the user's name, or other identification." See paragraph 25. Therefore Holmes-Kinsella teaches providing a request for service information, resubscribing the user to ongoing subscriptions when receiving the request (adding a new device to a subscription), and providing the service information in a single message sent in response to the request.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "said previous mobile terminal" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-8, 18-21, 23-25, 32, 33 and 35-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Mukherjee et al.

Regarding claim 1, Mukherjee discloses a method comprising storing service information (dynamic presence information) concerning a user (470) in a registrar (presence agent 204) and sending a subscription message (SUBSCRIBE) from a user terminal (465) to the registrar. See Figure 2 and paragraphs 52 and 116. A header in the subscription message contains a unique indication of a particular user. See paragraphs 97 and 98. The method also comprises, in response to the subscription message containing a unique indication in a header, returning a notification message (NOTIFY) to the user terminal. See paragraph 116. The payload (Message Body) of the notification message includes service information (presence information such as name, status, phone contacts) for the user to be used by the user terminal for communication services (presence applications). See Figure 7A and paragraphs 49, 50, 100, 101, and 115.

Regarding claim 2, Mukherjee discloses all of the limitations of claim 1, and also discloses that the user may have a plurality of ongoing communication services at the time that the subscription message is sent. See paragraphs 49 and 50.

Regarding claim 3, Mukherjee discloses all of the limitations of claim 2, and also discloses that the payload of the notification message includes service information for each of the ongoing communication services. See paragraphs 49 and 50.

Regarding claim 4, Mukherjee discloses all of the limitations of claim 1, and one of ordinary skill in the art recognizes that the subscription message may be sent after the user terminal experiences a failure.

Regarding claim 6, Mukherjee discloses all of the limitations of claim 1, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to a new terminal, and that the subscription message may be sent by the new terminal.

Regarding claim 7, Mukherjee discloses all of the limitations of claim 6, and one of ordinary skill in the art recognizes that the new terminal may be a different type of mobile terminal than the previous terminal.

Regarding claim 8, Mukherjee discloses all of the limitations of claim 1, and also discloses that the communication services include a push service and the registrar is a push proxy. See paragraphs 49 and 52.

Regarding claim 18, Mukherjee discloses all of the limitations of claim 1, and also discloses that the registrar comprises a SIP registrar, the subscription message comprises a SIP SUBSCRIBE message, the header comprises an event header, and

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the notification message comprises a SIP NOTIFY response. See paragraphs 85, 97, 98, 100, 101 and 117.

Regarding claim 19, Mukherjee discloses all of the limitations of claim 18, and also discloses that the user may have a plurality of ongoing communication services at the time that the SIP SUBSCRIBE message is sent. See paragraphs 49 and 50.

Regarding claim 20, Mukherjee discloses all of the limitations of claim 19, and also discloses that the payload of the SIP NOTIFY response includes service information for each of the ongoing communication services. See paragraphs 49 and 50.

Regarding claim 21, Mukherjee discloses all of the limitations of claim 18, and one of ordinary skill in the art recognizes that the SIP SUBSCRIBE message may be sent after the user terminal experiences a failure.

Regarding claim 23, Mukherjee discloses all of the limitations of claim 18, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to a new terminal, and that the SIP SUBSCRIBE message may be sent by the new terminal.

Regarding claim 24, Mukherjee discloses all of the limitations of claim 23, and one of ordinary skill in the art recognizes that the new terminal may be a different type of mobile terminal than the previous mobile terminal.

Regarding claim 25, Mukherjee discloses all of the limitations of claim 18, and also discloses that the communication services include a push service and the SIP registrar is a push proxy. See paragraphs 49 and 52.

Regarding claim 32, Mukherjee discloses a mobile terminal. The mobile terminal receives a plurality of communication services (presence applications) and sends a subscription message (SUBSCRIBE) to a registrar (presence agent 204). See Figure 2 and paragraphs 49, 50, 52 and 116. A header in the subscription message contains a unique identification of a particular user. See paragraphs 97 and 98. The mobile terminal also receives a notification message (NOTIFY) sent from the registrar in response to the subscription message. See paragraph 116. The payload (Message Body) of the notification message includes service information (presence information such as name, status, phone contacts) for the communication services. See Figure 7A and paragraphs 100, 101, and 115. The mobile terminal uses the service information included in the payload of the notification message to continue the communication services. See paragraphs 49 and 50.

Regarding claim 33, Mukherjee discloses all of the limitations of claim 32, and one of ordinary skill in the art recognizes that the subscription message may be sent after the user terminal experiences a failure.

Regarding claim 35, Mukherjee discloses all of the limitations of claim 32, and one of ordinary skill in the art recognizes that the user may switch from a previous terminal to the terminal, and that the subscription message may be sent by the terminal.

Regarding claim 36, Mukherjee discloses all of the limitations of claim 32, and also discloses that the subscription message comprises a SIP SUBSCRIBE message, the header comprises an event header, and the notification message comprises a SIP NOTIFY response. See paragraphs 85, 97, 98, 100, 101 and 117.

Regarding claim 37, Mukherjee discloses all of the limitations of claim 1, and also discloses that the unique indication comprises an event name particular to a specific user. See paragraphs 97 and 98.

Regarding claim 38, Mukherjee discloses all of the limitations of claim 1, and also discloses that the unique indication comprises identification of the particular user. See paragraphs 97 and 98.

Regarding claim 39, Mukherjee discloses all of the limitations of claim 32, and also discloses that the unique identification comprises an event name particular to a specific user. See paragraphs 97 and 98.

Claim Rejections - 35 USC § 103

7. Claims 10-13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan ("IMPS – Instant Messaging and Presence Using SIP") in view of Holmes-Kinsella (U.S. Patent Application Publication No. 2002/0147000).

Regarding claim 10, Donovan discloses a network architecture comprising a plurality of terminals and an inherent radio access network. The radio access network inherently contains elements providing information indicating the presence of the terminals. The network architecture also comprises a presence server. The presence server receives the information indicating the presence of the terminals. The network architecture also comprises an inherent communication service provider which provides a plurality of communication services, and a proxy server. The proxy server provides the communication services (instant messaging services) to the user terminals upon

subscription thereto, stores and maintains service information (presence information) related to the communication services, and provides the service information in a single message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal. Donovan does not disclose that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on resubscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new device, the service provider server resubscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Donovan with Holmes-Kinsella, such that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 11, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 10, and Donovan also discloses that the proxy server provides the service information in the payload of a notification message (NOTIFY) sent to the requesting terminal in response to the request.

Regarding claim 12, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11, and Donovan also discloses that the presence server, the proxy server, and the user terminal send message to each other according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 13, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 12, and Donovan also discloses that the request comprises a SIP SUBSCRIBE message.

Regarding claim 15, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. Furthermore, Donovan's user terminal may send the request after it experiences failure.

Regarding claim 16, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 11. In addition, when a user switches to a new user terminal from a previous user terminal, the new user terminal may send the request to the proxy server.

Regarding claim 17, Donovan in view of Holmes-Kinsella teaches all of the limitations of claim 16, and a new terminal may be a different type of user terminal than a previous user terminal.

8. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg in view of Holmes-Kinsella.

Regarding claim 27, Rosenberg discloses a proxy server which provides a plurality of communication services (instant messaging services) to a plurality of user terminals upon subscription of the user terminals to the communication services, stores and maintains service information (presence information) related to the communication services, and provides the service information in a single message (NOTIFY) sent in response to a request (SUBSCRIBE) from a user terminal. Rosenberg does not disclose that the proxy server resubscribes the user to ongoing subscriptions for which service information is stored when the proxy server receives the request from a user terminal.

Holmes-Kinsella discloses a system a method for adding new devices to a user's ongoing subscription. See Abstract. Adding a new device of a user to a user's subscription reads on resubscribing the user to an ongoing subscription. Holmes-Kinsella's system comprises a service provider which comprises a inherent server. The service provider's server acts as a proxy for information providers. See Figure 1 and paragraph 16. When a user having ongoing subscriptions requests services from the service provider server with a new device, the service provider server resubscribes the user to the ongoing subscriptions by updating the user's subscriptions to include the new device. See paragraphs 21 and 22. The main benefit of Holmes-Kinsella's invention is that a user may add new devices to the user's pre-existing subscriptions as they are acquired. See paragraphs 6-8. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to modify Rosenberg with Holmes-Kinsella, such that the proxy server resubscribes the user to ongoing subscription for which service information is stored when the proxy server receives the request from a user terminal, in order to allow the user to add new devices to the user's ongoing subscriptions as they are acquired.

Regarding claim 28, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 27, and Rosenberg also discloses that the proxy server provides the service information in the payload of a notification message (NOTIFY) to the requesting user terminal.

Regarding claim 29, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 28, and Rosenberg also discloses that the proxy server sends and receives messages according to SIP and that the notification message comprises a SIP NOTIFY response.

Regarding claim 30, Rosenberg in view of Holmes-Kinsella teaches all of the limitations of claim 29, and Rosenberg also discloses that the request comprises a SIP SUBSCRIBE message.

Allowable Subject Matter

9. Claims 5, 9, 22, 26 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

3/23/04

JKM

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
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